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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,972	01/15/2002	Andreas Peter Abel	2001_1861A	4434

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EXAMINER

YU, MELANIE J

ART UNIT	PAPER NUMBER
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1641

DATE MAILED: 05/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/030,972

Applicant(s)

ABEL ET AL.

Examiner

Melanie Yu

Art Unit

1641

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 01 May 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-47 and 81-91.
Claim(s) withdrawn from consideration: 48-63 and 92.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

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Continuation of 11. does NOT place the application in condition for allowance because: for the reasons stated in the previous office action dated 29 December 2005.

Regarding rejections under 35 USC 112, first paragraph, applicant argues that the subject matter of the claimed invention need not be described literally in order for the disclosure to satisfy the written description requirement. Applicant argues that figure 1 shows a sealing layer having a recess formed therein that defines a sample compartment. However, the specification does not specify that the sealing layer of figure 1 has a recess which forms the sample compartment. The specification also fails to teach whether the recess shown in figure 1 is a plurality of recesses in a single sample compartment or whether a single recess is a single sample compartment. Figure 1 labels (g) as a sealing layer but does not describe the opposite sides of the portion of the planar optical waveguide being recessed in order to define a sample compartment.

At page 15, applicant argues that the instant specification teaches that sample compartments are operable to be cleared of the received sample or reagent solutions, and the sample compartments are such that the sample or reagent solutions can be removed therefore. Applicant's arguments are not persuasive because although the specification provides the sample compartments being operable to clear sample or reagent solution, the specification does not teach how the compartments are adaptable or point to figure 1 to show the adaptation. The instant specification also does not teach adaptation to further receive other samples. Claim 1 is drawn to an apparatus claim, therefore sufficient description of all newly added product limitations must be included in the specification as originally filed.

Regarding claim 34, at page 15 applicant further argues that in Figure 1 the grating structure (c) extends over a portion of the sample compartment approximately 1/3 of the way across the sample compartment. However, applicant's argument is not persuasive because the specification does not provide sufficient explanation as to how much of the sample compartment must be covered in order to extend "over the range of multiple".

At pages 15-16, applicant argues rejections under 35 USC 112, second paragraph. Applicant argues that each of the recesses of the sealing layer forms a corresponding sample compartment to mean that one recess defines one sample compartment. Applicant's arguments are not persuasive because such limitations are not included in the instant claims or provided in the instant specification, therefore the claims are rendered vague and indefinite.

Applicant argues that Neuschäfer et al. fail to disclose or suggest a 2-dimensional array of measurement areas in each sample compartment. Applicant argues that Neuschäfer et al. teach a sample space that appears to represent only a single sample compartment and therefore do not teach a plurality of sample compartments. Applicant's arguments are not persuasive because Figures 3a-5a and 3b-5b show a plurality of sample compartments. Reference number 4 in Fig. 5a shows one sample compartment, sample compartments are arranged in a 4x3 two-dimensional array. Applicant further argues that the strip-like waveguiding regions defined by the divisions can, at best, correspond to a 1-dimensional array. However, the strips of Neuschäfer et al. are interpreted as a two-dimensional array. Each strip in the sample compartment, 4 in Fig. 5a, of Neuschäfer et al. has a length as shown in Figure 5a, reference numeral 2, and the combination of the strips together provides a width dimension. Therefore the array of discrete measuring areas of Neuschäfer et al. is a two-dimensional array. Furthermore, the instant specification as originally filed fails to provide a definition or figure sufficiently defining applicant's definition of a two-dimensional array.